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05 JAN 2006

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In re Application of: SHINOTSUKA, et al.	:	
Application No.: 10/693,204	:	DECISION ON PETITION UNDER
Filing Date: October 24, 2003	:	37 CFR 1.182
Attorney Docket No.: 7272-131/10312233	:	
For: OUTPUT-COMPENSATING DEVICE	:	
AND METHOD OF AN IMAGE	:	
SENSOR	:	

This decision is issued in response to the "Petition Under 37 CFR 1.182 To Accept Substitute Translation Of PCT Claims" filed May 02, 2005. Applicant has paid the required petition fee.

**BACKGROUND**

On March 28, 2002, applicants filed international application PCT/JP02/03089, which claimed a priority date of April 27, 2001 and which designated the United States. The deadline for submission of the basic national fee and national stage entry was thirty months from the priority date, i.e., October 27, 2004.

On October 24, 2003, applicants initiated the present U.S. application by filing a transmittal letter and accompanying materials, including a specification and thirty-two claims. The transmittal letter used by applicant identifies the submission initially as an "Entry National Phase (PCT)" based on PCT/JP02/03089. However, the transmittal letter also identified the submission as a "Filing Under 37 CFR 1.53(b)."

On January 28, 2004, the USPTO mailed a "Notice To File Missing Parts Of Nonprovisional Application Filed Under 37 CFR 1.53(b)" indicating that the submission had been treated as a filing under 35 U.S.C. 111(a) and 37 CFR 1.53(b). The Notice required submission of an oath or declaration in compliance with 37 CFR 1.63 and the surcharge for late filing the oath or declaration.

On March 18, 2004, applicants filed a response to the Notice, including an executed declaration and the required surcharge payment.

On April 04, 2004, the USPTO issued a filing receipt.

On May 02, 2005, applicants filed the petition considered herein.

### DISCUSSION

Any intended filing of an international application as a national stage application must clearly and unambiguously be identified as such and must satisfy all of the conditions set forth in 35 U.S.C. 371(c). See 37 CFR 1.495(g):

The documents and fees submitted ... must be clearly identified as a submission to enter the national stage under 35 U.S.C. 371, otherwise the submission will be considered as being made under 35 U.S.C. 111.

In addition, section 1893.03(a) of the MPEP states the following:

If there are any conflicting instructions as to whether the filing is under 35 U.S.C. 111(a) or 35 U.S.C. 371, the application will be accepted as filed under 35 U.S.C. 111(a).

As noted above, applicant's October 24, 2003 filing included a transmittal letter that referred to the submission as both a national stage filing and a submission under 37 CFR 1.53(b). The inclusion of these two descriptions of the submission constitutes "conflicting instructions" which, pursuant to the MPEP, requires that the application be treated under 35 U.S.C. 111(a). Accordingly, the original papers deposited on October 24, 2003 were correctly treated as a filing under 35 U.S.C. 111(a).

The present petition is based on the mistaken belief that the present application is a national stage filing under 35 U.S.C. 371 and, therefore, that a translation of the claims contained in the international application is required. The petition is moot because, as discussed above, the present application is not a U.S. national stage of PCT/JP02/03089. Rather, it is a U.S. application filed under 35 U.S.C. 111(a). Accordingly, the claims filed October 24, 2003 are the claims of record herein, and the replacement of these claims with the claims from the international application would not be appropriate without an amendment under 37 CFR 1.121 directing the USPTO to amend claims 1-32.

It is noted that the filing receipt mailed herein on April 05, 2004 lists PCT/JP02/03089 under "foreign applications." This is inappropriate as PCT/JP02/03089 was filed more than one year prior to the filing date of the present application. Accordingly, a corrected filing receipt is issued herewith wherein the reference to PCT/JP02/03089 as a foreign application has been removed.

The present U.S. application does not at present include a claim of priority to any prior-filed applications. Applicant may be entitled, subject to 37 CFR 1.78(a)(2)(ii), to claim benefit under 35 U.S.C. 120 and 365(c) of the filing date of the international application for the common subject matter, since this application (Serial No. 10/693,204) and the international application (PCT/JP02/03089) designating the United States were copending on October 24, 2003. In order to obtain benefit of the earlier international application, applicant must amend the beginning of the specification of this application by inserting a proper reference to the parent international application. An appropriate passage would be, "This is an continuation of

international application PCT/JP02/03089, filed 28 March 2002, which designated the United States and is now abandoned." Alternatively, applicant may submit an application data sheet with the benefit claim included therein. Applicant may need to file a petition and fee under 37 CFR 1.78(a)(3) to be entitled to make the claim.

Similarly, applicant may be entitled to claim the benefit of the Japanese priority applications identified in the international application. The addition of any such claims to the present application must be made pursuant to the requirements of 35 U.S.C. 119 and 37 CFR 1.55; a petition and fee under 37 CFR 1.55(c) may be required. In addition, applicant is reminded that in, order to perfect any claim for priority under 35 U.S.C. 119, applicant must submit a certified copy of the foreign priority documents. The certified copies of priority documents submitted to the International Bureau cannot be relied upon to perfect the claim for priority. See MPEP § 1896.

### CONCLUSION

For the reasons discussed above, the petition under 37 CFR 1.182 is **DISMISSED** as moot. The present application will continue to be treated as a filing under 35 U.S.C. 111(a) and 37 CFR 1.53(b). The claims of record are the claims filed with the original application papers on October 24, 2003.

If reconsideration on the merits of the petition is desired, a proper response must be filed within **TWO (2) MONTHS** of the mail date of the present decision. Any request for reconsideration should include a cover letter entitled "Renewed Petition Under 37 CFR 1.182."

Please direct further correspondence with respect to this petition to Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

The present application is being referred to the Technology Center Art Unit 2612.



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APPL NO.	FILING OR 371 (c) DATE	ART UNIT	FIL FEE REC'D	ATTY. DOCKET NO	DRAWINGS	TOT CLMS	IND CLMS
10/693,204	10/24/2003	2612	2596	7272-131/ 10312233	15	32	16

CONFIRMATION NO. 2344

000167  
FULBRIGHT AND JAWORSKI LLP  
555 S. FLOWER STREET, 41ST FLOOR  
LOS ANGELES, CA 90071

CORRECTED FILING RECEIPT



\*OC000000017716323\*

Date Mailed: 12/23/2005

Receipt is acknowledged of this regular Patent Application. It will be considered in its order and you will be notified as to the results of the examination. Be sure to provide the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION when inquiring about this application. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. If an error is noted on this Filing Receipt, please mail to the Commissioner for Patents P.O. Box 1450 Alexandria Va 22313-1450. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections (if appropriate).

Applicant(s)

Sukeyuki Shinotsuka, Sayama-shi, JAPAN;  
Atsushi Nakajima, Sayama-shi, JAPAN;  
Hironari Watanabe, Sayama-shi, JAPAN;

Assignment For Published Patent Application

Honda Giken Kogyo Kabushiki Kaisha

Power of Attorney: The patent practitioners associated with Customer Number 000167.

Domestic Priority data as claimed by applicant

Foreign Applications

If Required, Foreign Filing License Granted: 01/23/2004

The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is **US10/693,204**

Projected Publication Date: Not Applicable

Non-Publication Request: No

Early Publication Request: No

**Title**

Output-compensating device and method of an image sensor

**Preliminary Class**

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**PROTECTING YOUR INVENTION OUTSIDE THE UNITED STATES**

Since the rights granted by a U.S. patent extend only throughout the territory of the United States and have no effect in a foreign country, an inventor who wishes patent protection in another country must apply for a patent in a specific country or in regional patent offices. Applicants may wish to consider the filing of an international application under the Patent Cooperation Treaty (PCT). An international (PCT) application generally has the same effect as a regular national patent application in each PCT-member country. The PCT process **simplifies** the filing of patent applications on the same invention in member countries, but **does not result** in a grant of "an international patent" and does not eliminate the need of applicants to file additional documents and fees in countries where patent protection is desired.

Almost every country has its own patent law, and a person desiring a patent in a particular country must make an application for patent in that country in accordance with its particular laws. Since the laws of many countries differ in various respects from the patent law of the United States, applicants are advised to seek guidance from specific foreign countries to ensure that patent rights are not lost prematurely.

Applicants also are advised that in the case of inventions made in the United States, the Director of the USPTO must issue a license before applicants can apply for a patent in a foreign country. The filing of a U.S. patent application serves as a request for a foreign filing license. The application's filing receipt contains further information and guidance as to the status of applicant's license for foreign filing.

Applicants may wish to consult the USPTO booklet, "General Information Concerning Patents" (specifically, the section entitled "Treaties and Foreign Patents") for more information on timeframes and deadlines for filing foreign patent applications. The guide is available either by contacting the USPTO Contact Center at 800-786-9199, or it can be viewed on the USPTO website at <http://www.uspto.gov/web/offices/pac/doc/general/index.html>.

For information on preventing theft of your intellectual property (patents, trademarks and copyrights), you may wish to consult the U.S. Government website, <http://www.stopfakes.gov>. Part of a Department of Commerce initiative, this website includes self-help "toolkits" giving innovators guidance on how to protect intellectual property in specific countries such as China, Korea and Mexico. For questions regarding patent enforcement issues, applicants may call the U.S. Government hotline at 1-866-999-HALT (1-866-999-4158).

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The grant of a license does not in any way lessen the responsibility of a licensee for the security of the subject matter as imposed by any Government contract or the provisions of existing laws relating to espionage and the national security or the export of technical data. Licensees should apprise themselves of current regulations especially with respect to certain countries, of other agencies, particularly the Office of Defense Trade Controls, Department of State (with respect to Arms, Munitions and Implements of War (22 CFR 121-128)); the Bureau of Industry and Security, Department of Commerce (15 CFR parts 730-774); the Office of Foreign Assets Control, Department of Treasury (31 CFR Parts 500+) and the Department of Energy.

#### **NOT GRANTED**

No license under 35 U.S.C. 184 has been granted at this time, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" DOES NOT appear on this form. Applicant may still petition for a license under 37 CFR 5.12, if a license is desired before the expiration of 6 months from the filing date of the application. If 6 months has lapsed from the filing date of this application and the licensee has not received any indication of a secrecy order under 35 U.S.C. 181, the licensee may foreign file the application pursuant to 37 CFR 5.15(b).